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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/413,993	10/07/1999	JAMES E. LANDRY	S-1142	2682
2071 7590 07/21/2010 McGLINCHEY STAFFORD, PLLC Attn: IP Group 301 Main Street, 14th Floor BATON ROUGE, LA 70802				
EXAMINER				
SELLERS, ROBERT E				
ART UNIT		PAPER NUMBER		
1796				
MAIL DATE		DELIVERY MODE		
07/21/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/413,993

Applicant(s)

LANDRY ET AL.

Examiner

ROBERT SELLERS

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-18 is/are pending in the application.
- 4a) Of the above claim(s) 7-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 October 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Statement(s) (PTO/SF/23)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

1. Claims 10-18 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected inventions, there being no allowable generic or linking claim. (Claim 10 was inadvertently omitted in the statement of withdrawal set forth in the non-Final rejection mailed March 9, 2010. The non-Final rejection mailed May 25, 2001 acknowledges the inclusion of claim 10 in non-elected Group III.) Claims 7-9 are withdrawn as directed to non-elected species of
 - a) diglycidyl ether of bisphenol A mixed with a C₁₂-C₁₃ alkyl glycidyl ether and separate
 - c) C₁₂-C₁₃ alkyl glycidyl ether. The elections were made **without** traverse in the reply filed August 17, 2006.
2. The Replacement Sheets for the drawings allegedly accompanying the amendment filed July 9, 2010 as stated in the Remarks section on page 8, the last two paragraphs, have not been received. Accordingly, the drawings remain objected to due to the lack of removal of the border and title block as indicated in the Comments section of the Notice of Draftperson's Patent Drawing Review mailed May 25, 2001.
3. The issues raised in paragraphs 3, 4 on page 2 and paragraph 7 on page 4 of the non-Final rejection mailed March 9, 2010 have been resolved by the amendment.

4. The specification is objected to because the replacement of "Byk 361" with "The acrylic resin" in the amendment regarding page 7, line 11 of the specification exceeds the scope of enablement with respect to properties singularly attributed to the Byk 361. Furthermore, the lack of any description for Byk 361 renders unknown the type of component and structure of the Byk 361 employed in Component A on page 15, line 12. More favorable consideration would be given to page 7, line 11 to "Byk 361 is an acrylic resin which . . ."

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. The insulating material now amended to be "flexible" does not concisely denote the parameters thereof. The properties measuring flexibility are not described on page 1, lines 7-8 and page 5, lines 17-19. At what threshold flexibility is a material considered to be "flexible" as opposed to rigid? Even a concrete bridge exhibits oscillations caused by wind which could be within the claimed undefined "flexible."

6. The ceramic particles now characterized as having "thermal insulating properties" do not clearly define the metes and bounds thereof. There are no properties measuring thermal insulation on page 5, lines 10-13. At what threshold thermal insulation are ceramic particles deemed to be thermally insulating as opposed to heat conductive? Virtually any ceramic particles will withstand heat if exposed to a minimal heat source such as their placement in a room warmed at 24°C.

The text of those sections of Title 35, U.S. Code not included in this action can be found in the non-Final rejection mailed March 9, 2010.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wolf Patent No. 6,274,939; Scarlett Patent No. 6,956,079 or Neuner Patent No. 6,160,041.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bluem et al. Patent No. 6,214,460.

The rejections are maintained for the reasons of record set forth in the non-Final rejection. The arguments filed July 9, 2010 have been considered but are unpersuasive.

7. Wolf in column 5, lines 11-13 discloses ceramic fillers within the generically claimed ceramic particles. Although they are only characterized as not electrically conductive, there is nothing to indicate their thermal conductivity. Accordingly, the ceramic fillers of Wolf are inherently thermally insulating since there is no evidence of record to disprove it. Furthermore, due to the lack of parameters for what constitutes "thermal insulating," the ceramic fillers of Wolf are thermally insulating when placed in a merely warm environment of 25°C.

8. The concrete-like material of Neuner is employed as a building material according to column 2, lines 14-18. Even a building material exhibits some give due to winds and even when the subject of a minor earthquake. Therefore, the concrete-like material of Neuner exhibits flexibility within the claimed term wherein there are no parameters distinguishing it.

9. The formulation of Neuner is molded to form a cylinder according to column 4, line 65 to column 5, line 4. Any molding operation is concerned with the flowability of the blend prior to curing to uniformly conform to the mold. Accordingly, the motivation to incorporate the Byk 361 acrylic resin flow control agent of Scarlette to the molding formulation of Nuener in order to regulate the flow is entirely consistent with the molding operation of Neuner.

10. The claimed "insulating material initially prepared as separate mixtures" is product-by-process language.

According to MPEP § 2113, Product-by-Process Claims: Product-By-Process Claims are not Limited to the Manipulations of the Recited Steps, Only the Structure Implied by the Steps: "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." (*In re Thorpe*, 227 USPQ 964, 966, Federal Circuit 1985). "[T]he burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product." (MPEP § 2113, Burden Shifts to the Applicant to Show an Unobvious Difference and *In re Marosi*, 218 USPQ 289, 292, Federal Circuit 1983).

11. The insulating material in the product-by-process claim is obvious from the composition of Scarlett. The burden shifts to applicants to distinguish the claimed initial preparation of separate mixtures of an epoxy component and curing component over the mixing of the epoxy resin and curing agent reported in column 2, lines 18 and 40.

12. Alternatively, it would have been obvious to separate the epoxy resin and curing agent of Scarlett prior to combining them in order to prevent the premature reaction therebetween prior to curing.

13. The spherical thermally conductive, electrically insulating material of Bluem et al. includes ceramics according to column 15, lines 18-23. Although characterized as thermally conductive, the claimed thermally insulating ceramic particles are indistinguishable therefrom because the parameters for the thermally insulating property are not defined. The ceramic spheres of Bluem et al. embrace such species as aluminum oxide, glass, boron nitride and zinc oxide which are thermally conductive, yet at such a low level as to qualify within the undefined boundaries of the claimed thermal insulation.

The amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL** (MPEP § 706.07(a)). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

(571) 272-1093 (Fax No. (571)-273-8300)
Monday to Friday, 9:30 to 6:00

/Robert Sellers/
Primary Examiner
Division 1796

rs 7/16/2010